

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the amendments set forth above and the remarks below.

Claims 1-23 are pending in the application. Claims 12-14 are allowed. Claims 1-11 and 15-23 are rejected.

Case Summary

Applicant received a first Office Action on May 19, 2006 rejecting claims under §102 to Srivatsa. Applicant received a second non-final Office Action on October 6, 2006 rejecting claims under §102 over Huet. Applicant received a third Office Action on February 9, 2007 rejecting claims under §102 over Triplett. Applicant received the fourth (and present) Office Action on October 29, 2008 rejecting claims under §102 over Sasso. Applicant submits that the piecemeal searching and serial application of references in a series of Office Actions is extremely unfair to Applicant and contrary to the MPEP which states that piecemeal examination should be avoided. Applicant has responded to the Examiner's assertions in each Office Action only to receive a further Office Action. In addition, Applicant has taken action and incurred cost based upon the Examiner's previous assertions. For example, Applicant previously rewrote claim 5 in independent form based upon the Examiner's indication that this claim contained patentable subject matter, subsequently withdrawn by the Examiner. Applicant submits, with much and sincere respect for the Examiner, that it is more than reasonable for the Applicant to expect that addressing and overcoming rejections in the present Office Action will result in allowance of the application and not a further Office Action.

The Claim Objections

The Examiner objected to claim 17, which is amended as set forth above, to correct the inadvertent error pointed out by the Examiner.

The Prior Art Rejections:

Claims 1-11 and 15-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Sasso (US 2002/0111581).

The Examiner asserts on pages 2-3 of the present Office Action that

“Sasso teaches a housing (20) having a first (30) and second (28 and 26) portions having a first (attached to 26) and second (free) ends, the second housing portion having a first position (Fig. 1) in the use position and second (Fig 3) position in the non-use position, the first housing portion extending along an axis (length-wise axis, Fig 1); a longitudinal member (38) having first (pointed) and second (base of the “V” shape) ends, the longitudinal member extending from the housing along the axis in the use position (Fig. 1) and being captured by the first housing portion (indent 42, see also Fig 4) in the non-use position; and a needle (22) extending downwardly (Fig 1) from the housing in the use position and being captured (Fig 2) by the housing in the non-use position.”

Claim 1 is amended to clarify that “a longitudinal member having first and second ends, the longitudinal member extending from the first housing portion along the axis in the use position and being movable along the axis with respect to the first housing portion until captured by the first housing portion in the non-use position.” With this arrangement, the longitudinal member extends from the first housing portion along an axis in the use position, and moves along the axis until captured by the first housing portion.

The Examiner equates the “planar wing” 30 of Sasso with the claimed first housing portion and the “arrowhead shaped wall 38” with the claimed longitudinal member. The wall 38 does not extend from the wing 30. In addition, the wall 38 does not move along an axis, as required by amended claim 1, but rather, rotates about an arc until the wings 28,30 come together. Sasso does teach or suggest any type of axial movement, only rotation about the central hub 26.

In view of the above, Applicant submits that claim 1 is patentably distinguishable over Sasso. For at least the same reasons, Applicant submits that claims 2-4, 7-11, and 15-16 are also distinguishable.

Claim 5 requires:

“A medical device having a use position and a non-use position, comprising:

 a housing having first and second portions each having respective first and second ends, the second portion having a first position in the use position and a second position in the non-use position, the first housing portion extending along an axis;

 a longitudinal member having first and second ends, the longitudinal member extending from the housing along the axis in the use position and being captured by the first housing portion in the non-use position; and

 a needle extending from the device in the use position and not extending from the device in the non-use position,

 wherein the first end of the longitudinal member is coupled to a first end of the second housing portion, the second end of the first housing portion is coupled to the second end of the second housing portion, *the second housing portion includes first and second pieces pivotably coupled to each other*, and

 wherein the *second housing portion* includes a *slot* for enabling transition of the device from the use position to the non-use position unencumbered by the needle.”

With regard to claim 5, the Examiner only states that “[a]s to claim 5, the second housing portion includes a slot (34) for receiving the needle.” Applicant fails to point to any teaching in Sasso for the claimed feature that “*the second housing portion includes first and second pieces pivotably coupled to each other.*” Moreover, Applicant submits that Sasso does not disclose or suggest any such feature.

Notwithstanding the above, in the interest of expediting allowance of the present application, Applicant amends claim 5 to clarify that “*the second housing portion includes first and second pieces pivotably coupled to each other such that the second housing portion is generally flat in the use position and the first and second housing portions pivot to capture the needle in the non-use position.*”

Applicant submits that Sasso clearly fails to contemplate such a structure. For at least the same reasons, Applicant submits that claim 6 is also distinguishable over Sasso.

In reviewing the Office Action, Applicant could not identify any discussion of claim 17 and the grounds for rejection. In view of this, while Applicant believes that claim 17 and the entire application is in condition for allowance, Applicant submits that a further Office Action rejecting claim 17 cannot properly be made final since Applicant would not have any opportunity to address a rejection of claim 17.

Moreover, Applicant submits that claim 17 is allowable over Sasso. Claim 17 requires: “A method of providing safety in medical device having a use position and a non-use position, comprising:

providing a housing for receiving a longitudinal member having first and second ends and a channel, the housing having first and second portions each having first and second ends, the first housing portion extending along an axis, the longitudinal member extending from the housing along the axis in the use position;

connecting the first end of the second housing portion to the first end of the longitudinal member;

connecting the second end of the first housing portion to the second end of the second housing portion; and

affixing a needle to the device extending from the first housing portion through the channel in the use position;

wherein compressive pressure applied in a direction substantially parallel to the axis at the first end of the longitudinal member in the use position forces the first and second housing portions to pivot and extend from the first housing portion and envelop the needle.”

Applicant submits that Sasso fails to teach anything remotely akin to a structure providing “*compressive pressure applied in a direction substantially parallel to the axis at the first end of the longitudinal member in the use position forces the first and second housing portions to pivot and extend from the first housing portion and envelop the needle.*”

Applicants that claim 17, as well as dependent claims 18-20, are distinguishable over Sasso.

In view of the above, Applicant submits that claims 1-23 are in condition for allowance for which a notice thereof is respectfully requested.

The Examiner is respectfully invited to telephone the undersigning attorney if there are any questions regarding this Response or this application.

Applicant does not acquiesce to any assertion made by the Examiner not specifically addressed herein.

The Assistant Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 500845, including but not limited to, any charges for extensions of time under 37 C.F.R. §1.136.

Respectfully submitted,

Dated: April 22, 2008

DALY, CROWLEY, MOFFORD & DURKEE, LLP

By: /Paul D. Durkee/
Paul D. Durkee
Reg. No. 41,003
Attorney for Applicant(s)
354A Turnpike Street - Suite 301A
Canton, MA 02021-2714
Tel.: (781) 401-9988, Ext. 121
Fax: (781) 401-9966
pdd@dc-m.com

66579